Attorney Docket No.: DEX-0184
Inventors: Roberto A. Macina
Serial No.: 09/806,311
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REMARKS

Claims 1-11 are pending in the instant application. Claim 1 has been amended in accordance with teachings at page 1, lines 4-5 and page 2, line 3 through page 3, line 2. Thus, no new matter is added by this amendment and entry is respectfully requested.

Claims 1-11 have been subjected to a Restriction Requirement as follows:

Group I, claims 1 and 6, drawn to a method of diagnosing gastrointestinal cancer;

Group II, claims 2-6, drawn to a method of diagnosing metastases of gastrointestinal cancer in a cancer patient;

Group III, claim 7, drawn to an antibody;

Group IV, claims 8-9, drawn to a method of imaging gastrointestinal cancer; and

Group V, claims 10-11, drawn to a method of treating gastrointestinal cancer.

The Examiner suggests that Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. The Examiner suggests that the special technical feature linking these claims is an antibody to SEQ ID NO:2 and that this is taught by WO 96/39541. Therefore the

Examiner suggests that the Groups below are not linked as to form a single general concept under PCT Rule 13.1.

Applicant respectfully traverses this Restriction Requirement.

At the outset, Applicant respectfully disagrees with the Examiner's suggestion that the general inventive concept of the present invention is an antibody to SEQ ID NO:2. The inventive concept linking the claims of the instant application is the discovery of SEQ ID NO:2 as a cancer marker, particularly with respect to cancer of the stomach and small intestine. This concept is clearly a contribution over the cited prior art and the basis for this Restriction Requirement is flawed.

Further, this Restriction Requirement, at least with respect to claims 1-7, directly contradicts both the Search Report and the Written Opinion issued by this same Examiner in the PCT application of which this case is the U.S. National Stage.

In addition, MPEP §803 provides two criteria which must be met for a Restriction Requirement to be proper. The first is that the inventions be independent or distinct. The second is that there would be a serious burden on the Examiner if the restriction is not required. A search of the prior art relating to pending claims 1-7 has already been performed by this Examiner

in the PCT application. Thus, there is clearly no burden placed upon the Examiner by including at least claims 1-7 in this case, since these claims were already searched and examined by the Examiner in the PCT application.

Accordingly, since this Restriction Requirement does not meet the criteria as set forth in PCT Rule 13.1 and 13.2 or MPEP § 803 to be proper, it is respectfully requested that this Restriction Requirement be withdrawn.

In an earnest effort to be completely responsive, however, Applicant elects Group I, claims 1 and 6, with traverse.

Applicant believes that the foregoing comprises a full and complete response to the Office Action of record.

Respectfully submitted,

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